

II. REMARKS/ARGUMENTS

A. Remarks.

The drawings filed on December 8, 2003 are objected to since Figure 7 contains an unlabeled box. Claims 1, 2, 6-8, 11-14, 16, 17, 26, 27, and 29-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fujii et al. U.S. Patent No. 5,905,520. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujii et al. '520. Claims 3-5, 9, 10, 15, 18-22, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 32 has been allowed. Four previously dependent claims have been amended into independent claims. The Director is authorized to charge these fees for the new independent claims to deposit account number 02-0429. A fee transmittal is included with this response authorizing payment for these claims.

B. Response

1. Drawings

The drawings stand objected to because previously filed Figure 7 contained unlabeled boxes. The boxes illustrated on Figure 7 have now been labeled, a "Replacement Sheet" in compliance with 37 C.F.R. § 1.84(c) reflecting this correction is attached hereto for submission with this response.

2. 35 U.S.C. § 102(b) – Claims 1, 2, 6-8, 11-14, 16, 17, 26, 27, and 29-30

Claims 1, 2, 6-8, 11-14, 16, 17, 26, 27, and 29-31 stand rejected under 35 U.S.C. §102(b) as being anticipated by Fujii et al. '520. Fujii et al. '520 was cited as disclosing a paper handler in combination with a printer comprising a paper inlet and outlet as paper exits the paper handler

to the inlet of the printer (Figure 10). Fujii et al. '520 was also cited as having a controller for communication between the handler and printer and controlling the cutting operation of the paper handler. Further, the paper handler of Fujii et al. '520 was stated to have a drag system in the form of a buffer and roller to maintain tension on the paper.

In response, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Claims 1 and 17 are being amended with this paper to include a value of a drag force applied to the paper in the range of about 0.8 N to about 1.11 N (3-4 ounces). Support for this amendment can be found on page 18 lines 13 – 15 of the originally filed specification. Fujii et al. '520 does not mention a drag force value, accordingly Fujii et al. '520 does not include each and every element of claims 1 and 17 as amended. Thus Fujii et al. '520 is not an appropriate reference for the rejection of these claims under 35 U.S.C. 102(b), it is therefore respectfully requested that Fujii et al. '520 be removed as a basis for the rejection of claims 1 and 17. Since claims 2, 6-8, 11-14, 16, 26-27, and 29-31 depend from claim 1 or 17, directly or indirectly, it is respectfully requested that Fujii et al. '520 be removed as a basis for the rejection of these claims as well.

2. 35 U.S.C. § 103(a) – Claim 23

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujii et al. '520. It was asserted that while Fujii et al. '520 did not disclose a jam detection system, one of ordinary skill in the art would be motivated to install such a system.

In response, to sustain a rejection under 35 U.S.C. § 103(a) a prima facie case of obviousness must be established. M.P.E.P. § 2142. To establish a prima facie case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Id. Second, there must be a reasonable expectation of success. Id. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. Id.

Claim 23 depends from now amended claim 17. As noted above claim 17 includes the limitation of a specific drag force applied to the paper entering the paper handler. This limitation is not found within Fujii et al. '520; as such Fujii et al. '520 does not teach or suggest all the claim limitations of claim 23. As such, it is respectfully requested that Fujii et al. '520 be removed as a basis for the rejection of claim 23.

C. Allowable Subject Matter – Claims 3-5, 9, 10, 15, 18-22, 24, and 25

Claims 3-5, 9, 10, 15, 18-22, and 24-25 stand objected to as being dependent upon a rejected base claim, but were found to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Furthermore, claim 32 as originally filed was found to be allowable. Claims 3-5, 9, 10, 15, 18-22, and 24-25 have been amended with this paper to include the limitations of their respective base claims, as well as the limitations of any intervening claims. These claims should now be in condition for allowance and their early allowance is respectfully requested.

D. Cited References

References were cited in the Office Action that were not otherwise referenced in the body of the Office Action. Those references are Lloyd U.S. Patent No. 3,859,960 and Abreu U.S. Patent No. 5,279,536. These references do not add information to issues already raised and discussed, and as such do not affect the patentability of the claims of the subject application.

III. CONCLUSION

It is respectfully urged that in light of the above stated amendments and submissions that applicants' claims are patentable in light of the prior art and that the rejections of claims 1, 2, 6-8, 11-14, 16, 17, 26, 27, 29-31 under 35 U.S.C. § 102(b) and claim 23 under 35 U.S.C. § 103(a) should be removed. Furthermore, as claims 3-5, 9, 10, 15, 18-22, and 24-25 have been amended in accordance with the Examiner's instructions, these claims are now in condition for allowance. It is believed that the foregoing response is full and complete. Applicants respectfully request reconsideration of the instant application in light of the foregoing response and amendments.

Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of the application, the Examiner is invited to contact the Applicants' representative by telephone or fax.

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Respectfully submitted,



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